

REMARKS

Entry of the foregoing, reexamination and further and favorable consideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.116, are respectfully requested.

I. Amendments to the Claims

By the foregoing amendment, claim 7 has been amended to be directed to a "method of treating skin diseases . . . , wherein the skin diseases are selected from the group consisting of skin cancer, pigmentation disease, photoaging, atopy, urticaria and allergy." Support for this amendment can be found throughout the present application including, for instance, page 12, lines 1-6 and the original claims. Additionally, claims 20-21 have been canceled without prejudice or disclaimer to the subject matter recited therein. Applicants reserve the right to file a continuation or divisional application directed to any canceled subject matter. Further, claim 24 has been added. Like claim 7, claim 24 is directed to a method of treating skin diseases. However, in claim 24, the method involves administering a composition "consisting of i) an isolated EC SOD protein or an expression vector comprising a polynucleotide encoding the EC SOD protein; and ii) pharmaceutically acceptable carrier" (emphasis added) and the skin disease is "dermatitis or psoriasis." Support for claim 24 can be found throughout the present application including, for example, page 12, lines 1-12 and the original claims. No new matter has been added.

II. Rejection Under 35 U.S.C. § 112

Claim 20 has been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

To expedite prosecution in the present application and not to acquiesce to the Examiner's rejection, claim 20 has been canceled without prejudice or disclaimer to the subject matter recited therein. Since this rejection has been rendered moot, withdrawal of such rejection is appropriate.

III. Rejection Under 35 U.S.C. § 102

Claims 7 and 20-21 have been rejected under 35 U.S.C. § 102(b) as purportedly being anticipated by Hersh (U.S. Patent No. 6,011,067). This rejection is respectfully traversed.

Initially, it is noted that the rejection is moot as it pertains to claims 20 and 21 as such claims have been herein canceled without prejudice or disclaimer to the subject matter recited therein.

As to claim 7, and to the extent applicable to new claim 24, the Hersh patent fails to be a proper anticipatory references as it does not teach, either expressly or inherently, each and every element of the claims.

In particular, claim 7, as-amended, recites that "the skin diseases are selected from the group consisting of skin cancer, pigmentation disease, photoaging, atopy, urticaria and allergy." However, the Hersh patent does not disclose, explicitly or inherently, any of these diseases recited in claim 7. Since the Hersh patent does not disclose all of the elements of claim 7, it can not be used as an anticipatory reference against claim 7.

Claim 24 is directed to a method of treating skin disease wherein the skin disease is dermatitis or psoriasis. However, as recited in claim 24, the composition administered "consist[s] of i) an isolated EC SOD protein or an expression vector comprising a polynucleotide encoding the EC SOD protein; and ii) pharmaceutically acceptable carrier . . ." (Emphasis added.) The composition used in the method of

claim 24 differs from the composition disclosed in the Hersh patent, which comprises L-glutathione, a source of selenium, SOD (as an “optional expedient”), and suitable carriers. Accordingly, the Hersh patent does not anticipate claim 24 of the present application.

In view of the above, the Examiner is respectfully requested to withdraw the art rejection over the Hersh patent.

IV. Finality of the Office Action Mailed February 20, 2009

The Examiner stated the new grounds of rejection presented in the Office Action were necessitated by Applicants' amendment. See OFFICE ACTION at 3. Applicants respectfully disagree that the rejection of the claims over the Hersh patent was necessitated by any amendment made by the Applicants. Instead, it appears that the Examiner found the Hersh patent after issuance of the first Office Action. This is supported by the fact that the Hersh patent was cited in a PTO-892 form by the Examiner for the first time along with the Office Action mailed on February 20, 2009. Thus, the basis for the new grounds of rejection at this particular time seems grounded in the fact that the Examiner just discovered the Hersh patent, not because of any amendment made by Applicants. In instances like these, where the Examiner introduces a new grounds of rejection in a second or subsequent Office Action, the Office Action should not be made final. See M.P.E.P. § 706.07(a). Thus, in accordance with section 706.07(d), Applicants' respectfully request withdrawal of the premature finality of the Office Action mailed on February 20, 2009.

V. Conclusion

In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited.

In the event that there are any questions related to this Amendment and Reply, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney at the below-listed telephone number concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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